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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,876	11/04/2003	Satoshi Nishikawa	00862.023296.	3495
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EXAMINER				
WILLS, LAWRENCE E				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,876

Applicant(s)

NISHIKAWA, SATOSHI

Examiner

LAWRENCE E. WILLS

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,11,13,14,21,23,24 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,11,13,14,21,23,24, 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/9/2008 has been entered.

Response to Arguments

Applicant's arguments filed 7/9/2008 have been fully considered but they are not persuasive. Applicant alleges that "Livingston discloses a method for selective application of imaging related options to arbitrary pages. The selected feature is applied to the selected page or pages. According to Livingston, a setting value is set for a setting item, then the user is allowed to select pages to which the setting value is applied. Therefore, Livingston discloses that a program module passes the values of variables in a data structure to a printer driver so that an imaging operation can be performed on a per page basis. Thus, in Livingston, setting values are passed to a printer driver for selected pages. However, Livingston fails to disclose a basic setting combined with an exceptional setting. Therefore, Livingston cannot possibly disclose an entire color mode to be applied to an entire document data as a setting value for an item to set a color mode, setting a partial color mode to be applied to a predetermined unit of the document data as a setting value for the item, and generating the print data so that the printer prints a print material on which the partial color mode is applied to the predetermined unit and the entire color mode is

applied to the remaining portion of the document data for which the partial color mode is not applied, wherein both the entire color mode and the partial color mode are set as the setting value for the item”.

However, column 3, lines 33-41 in the Livingston reference state "the program module includes the capability to select certain preset classes of pages for applying one or more of the features. For example, the program module could include selections that would allow the user to apply the selected features to all of the pages, the first page of the document, the last page of the document, even pages in the document, odd pages in the document, or the current page". When a user selects a mode for on class of pages, i.e. whole document, and then goes on to select a different mode for another set of pages, i.e. even pages, the even pages would inherently have the setting of the whole page and the even pages. Livingston, in column 7, lines 44-50, further states a number of examples where the program module flexibility in a situation where the program module would receive information from the application program specifying which pages includes color.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4, 11, 14, 21, 24, 31, 32, and 33 are rejected under 35 U.S.C. 102(c) as being anticipated by Livingston (US Patent 7,061,632).

Regarding claims 1, 11, and 21 Livingston'632 teaches an information processing apparatus having a generation function of generating print data to be transmitted to a printer (Shown in FIG. 1 is a high level block diagram of a system including a computer 100 and an imaging device, such as printer 102, in which the program module operates to generate hard copy, column 3, lines 43-46), comprising: an entire print setting unit (All pages selection, column 5, line 18) configured to set an entire color mode (feature) to be applied to the entire document data as a setting value for an item to set a color mode (applies the feature to every page in the document, column 5, lines 18-19), a partial print setting unit (In addition to the preset page classes, program module 202 includes a configuration to apply the selected feature or features to an arbitrary page or pages of the document created by the user. The pages to which the user desires to apply the feature or features may be specified individually or as part of a range, column 5, lines 30-35) configured to set a partial color mode to be applied to a predetermined unit of the document data as a setting value for the item (For this capability, program module 202 would receive information from the application program specifying which pages include color. With this information from the application program, program module would cause those pages of the print job including color to be sent to the selected destination printer. Another preset page class includes monochrome only pages. This preset page class would allow the user to direct monochrome only pages to a selected destination printer); and a print data generating unit (printer driver 204 Fig. 2) configured to generate the print data so that the printer prints a print material on which the partial color mode is applied to the predetermined unit and the entire color mode is applied to the remaining portion of the document data for which the partial color mode is not applied (Next, in step 606, program module 202 sets the values of

the variables in the array of data structures corresponding to the pages to which the user assigned features. Finally, in step 608, program module 202, sends the data for the pages to the destination imaging device through printer driver 204. column 9, lines 21-30), wherein both the entire color mode and the partial color mode are set as the setting value for the item (In addition, program module 202 passes the values of the variables in the data structure to printer driver 204 so that the imaging operation can be performed on a per page basis according to the values of the variables in the corresponding data structure. column 9, lines 21-30).

Regarding claims 4, 14, and 24, Livingston'632 teaches wherein said printing data generating unit (printer driver 204 Fig. 2) determines whether the printer copes with a change of the color mode (Step 606, Fig. 6) before the print data containing the instruction of changing the color mode is generated by using the generating function (Step 608, Fig. 6), when the printer copes with the change, generates, by using the generating function, printing data containing the instruction of changing the color mode, and when the printer does not cope with the change, generates, by using the generating function, print-data containing no instruction of changing the color mode (In addition, program module 202 passes the values of the variables in the data structure to printer driver 204 so that the imaging operation can be performed on a per page basis according to the values of the variables in the corresponding data structure. column 9, lines 21-30, the values of the variables will be decided if data is changed or not).

Regarding claims 31, 32, and 33, Livingston'632 teaches wherein the entire color mode is set for specifying whether color printing or monochrome printing is performed for the entire

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document data, and the partial color mode is set for specifying whether color printing or monochrome printing is performed for the predetermined unit of the document data (For this capability, program module 202 would receive information from the application program specifying which pages include color. With this information from the application program, program module would cause those pages of the print job including color to be sent to the selected destination printer. Another preset page class includes monochrome only pages. This preset page class would allow the user to direct monochrome only pages to a selected destination printer).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3, 13, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston (US Patent No. 7,061, 632) as applied to claim 1, 11, and 21 above, and in further view of Petz (WO 2002/82362 A2—US Patent Application Pub. No. 2004/0187087 is used in lieu of English translation).

Regarding claims 3, 13, and 23, Livingston'632 fails to teach wherein the predetermined unit of the document data is a chapter formed by a plurality of original pages.

Petz'362 teaches the predetermined unit of the document data is a chapter formed by a plurality of original pages, (notice Fig. 6A).

Having a system of Livingston'632 reference and then given the well-established teaching of Petz'362 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image processing system of Livingston'632 reference to include chapters that are formed by a plurality of original pages as taught by Petz'362 reference, since the combination would allow for the user to have greater control over the output of a print job.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Momose et al. (US Patent No. 6,301,013)

Glass et al. (US Patent No. 6,041,200)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAWRENCE E. WILLS whose telephone number is (571)270-3145. The examiner can normally be reached on Monday-Friday 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

LEW
August 4, 2008